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Legal Department, DL429
Intellectual Property Administration
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ATTORNEY DOCKET NO. 10004187-3

1FW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Jay K. Bass, et al.

Serial No.: 10/652,114

Examiner: Betty J. Forman

Filing Date: August 29, 2003

Group Art Unit: 1634

Title: METHODS FOR MANUFACTURING ARRAYS

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- ☒ Response/Amendment ☐ Petition to extend time to respond
☐ New fee as calculated below ☐ Supplemental Declaration
☐ No additional fee (Address envelope to "Mail Stop Amendments")
☐ Other: (Fee \$ _____)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X 50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X 200	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ 360	\$ 0
EXTENSION FEE	1 ST MONTH 120.00 <input type="checkbox"/>	2 ND MONTH 450.00 <input type="checkbox"/>	3 RD MONTH 1020.00 <input type="checkbox"/>	4 TH MONTH 1590.00 <input type="checkbox"/>		\$ 0
OTHER FEES						\$ 0
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

Jay K. Bass, et al.

By


Theodore J. Leitereg
Attorney/Agent for Applicant(s)

I hereby certify that this correspondence is being Deposited with the United States Postal Service as First class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: May 16, 2006

Typed Name: Theodore J. Leitereg

Signature: 

Reg. No. 28,319

Date: May 16, 2006

Telephone No. 408-553-4377



CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, on May 16, 2006.

Signature

Name: Theodore J. Leitner

Date

5/16/06

PATENTS

Attorney Docket No. 10004187-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application: 10/652,114

Inventors: Jay K. Bass, *et al.*

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Response to Restriction Requirement

This paper is responsive to the Restriction Requirement in the Office Action dated April 20, 2006, from the U.S. Patent and Trademark Office in the above-identified patent application.

Restriction Requirement

Restriction was required under 35 U.S.C. §121 as follows:

Group I – Claims 30-39 and 44-49, drawn to an apparatus, classified in class 435, subclass 288.5.

Group II – Claims 40-43, drawn to methods of sampling and reading an array, classified in class 435, subclass 6.

In making the Restriction Requirement, a determination was made in the Office Action that the inventions of Groups I and II are distinct each from the other.

According to M.P.E.P. 802.01 the term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (emphasis in original). Accordingly, in making the restriction requirement the Office Action is acknowledging at least implicitly that the inventions of the aforementioned groups are separately patentable over one other. If this were not the case, then the restriction requirement would not be proper.

Furthermore, it follows from the above that art (if such art exists) indicating that the invention of one of the groups is known or would have been obvious would not extend to a holding that the inventions of the other groups are known or would have been obvious. For example, art that might anticipate or render obvious an apparatus for synthesizing an array of biopolymers on the surface of a support as set forth in claim 30 (and claims depending therefrom) would not render known or obvious a method comprising using an array, prepared by an apparatus according to claim 30, by exposing the array to a sample and reading the array as set forth in claim 40 (and claims depending therefrom) or vice versa. Again, if this were not the case, then the restriction requirement with respect to those claims would not be proper.

In response to and as required by the Restriction Requirement, Applicant elects the invention of Group I, claims 30-39 and 44-49, with traverse. Applicant reserves the right to file divisional patent applications to the subject matter that the Office Action has determined to be patentably distinct and separately patentable.

Product and Process Claims

The Office Action noted that restriction was required between product and process claims. Applicant acknowledges the indication in the Office Action that, where product claims are elected (such as elected above) and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of M.P.E.P. §821.04. Method claims 40-43

already are dependent from apparatus claim 30 and, thus, fulfill the above requirement with respect to withdrawn process claims (although such claims are not officially withdrawn).

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Theodore J. Leitereg", with a long horizontal flourish extending to the right.

Theodore J. Leitereg
Attorney for Applicant
Reg. No. 28,319

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